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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/368,866	08/05/99	LINAS-BRUNET	M 13/068

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BOEHRINGER INGELHEIM CORPORATION
900 RIDGEBURY ROAD
P O BOX 368
RIDGEFIELD CT 06877

EXAMINER

OSWECKI, J

ART UNIT

PAPER NUMBER

1626

DATE MAILED:

04/17/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/368,866

Applicant(s)

Linus-Brunet et al.

Examiner

Jane Oswecki

Group Art Unit

1626



☒ Responsive to communication(s) filed on Mar 12, 2001

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-26, 28-80, and 84-87 is/are pending in the application.

Of the above, claim(s) 73-80 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1, 49, 51, 53, 55, 57, 59, 61, 63, and 65 is/are rejected.

☒ Claim(s) 2-26, 28-48, 50, 52, 54, 56, 58, 60, 62, 64, 66-72, and 84-87 is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☒ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

Jane C. Oswecki
JANE C. OSWECKI
PRIMARY EXAMINER
ART UNIT 1626

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Claims 1-26, 28-80 and 84-87 are pending in the application. All cited references have been considered and any cited but not applied are cited to show the state of the art. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112, Second Paragraph

Claims 49, 51, 53, 55, 57, 59, 61, 63 and 65 are rejected for listing compounds by compound numbers drawn from a table rather than by nomenclature or structure. These claims fail to "particularly pointing out and distinctly claim" the subject matter intended by applicants for the reasons set forth in Paper No. 12. (See 37 C.F.R. 1.58.)

Claim Rejections - 35 USC § 112, First Paragraph

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The proviso found in claim 1 regarding substituents R₄ and B is unclear. Support for applicants' proposed amendment to claim 1 for this proviso is not found (See specification at p. 5,

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line 8 et seq.). It is requested that support in the specification be indicated for any proposed amendments to the claim.

Claim Objections

Claim 1 is objected to because of the following informalities: claim 1, last three lines, in the definition of "Het" is objected to for embracing heterocycles that are non-elected under the terms of the Restriction Requirement, Group II of Paper No. 7.

Claims 2-26, 28-48, 50, 52, 54, 56, 58, 60, 64, 66-72 and 84-87 are rejected as depending from a rejected base claim.

Response to Amendments

Applicants' amendments in Paper No. 13 filed March 12, 2001, have been considered and are found sufficient to overcome the rejection of claims 1, 5-7, 11-14, 30, 32, 36, 37 and 45-47 under 35 U.S.C. 112, second paragraph, and the objections to claims 15, 19, 29, 46, 62 and 87 for the reasons set forth in Paper No. 12.

However, applicants' amendments are found insufficient to overcome the rejection of claims 49, 51, 53, 55, 57, 59, 61, 63 and 65 for listing compounds by compound numbers drawn from a table rather than by nomenclature or structure; for elucidating the proviso in claim 1; for overcoming the objection to claim 1 for containing non-elected subject matter; and for overcoming the objections to claims 2-4, 8-10, 15-26, 28, 29, 31, 33-35, 38-44, 48, 50, 52, 54, 56, 58, 60, 62, 64, 66-72 and 84-87 as depending from a rejected base claim.

Response to Arguments

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Applicants' arguments filed in Paper No. 13 of March 12, 2001, have been fully considered and are deemed sufficient to overcome the rejection of claims 1, 5-7, 11-14, 30, 32, 36, 37 and 45-47 under 35 U.S.C. 112, second paragraph, and the objections to claims 15, 19, 29, 46, 62 and 87 for the reasons set forth in Paper No. 12.

Applicants' arguments are deemed insufficient to overcome the traversal of the Restriction Requirement of Paper No. 7; the rejection of claims 49, 51, 53, 55, 57, 59, 61, 63 and 65 for listing compounds by compound numbers drawn from a table rather than by nomenclature or structure; for elucidating the proviso in claim 1; for overcoming the objection to claim 1 for containing non-elected subject matter; and for overcoming the objections to claims 2-4, 8-10, 15-26, 28, 29, 31, 33-35, 38-44, 48, 50, 52, 54, 56, 58, 60, 62, 64, 66-72 and 84-87 as depending from a rejected base claim.

The applicants argue their traversal of the Restriction Requirement in Paper No. 7 between the final product compounds of Groups I-VII and the intermediate compounds of Group XI. The restriction requirement was made final in Paper No. 12.

Applicants maintain that the intermediate compounds taught by Ishikawa et al. (JP 05-155827) are structurally distinct from the intermediate compounds of Group XI. This distinction is not seen. Rather, claims 76-79 which constitute Group XI have a cyclopropyl moiety substituted by a protected carboxy group, an amino group, and an alkyl, cycloalkyl or alkenyl group, the functional moiety of which is the carboxy group. Ishikawa teaches a cyclopropyl moiety substituted by an amino or protected amino group and a protected carboxy group (JP 05-

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155827, Abstract). As with the instant application, Ishikawa teaches the use of this amino-cyclopropyl-carboxylic acid derivative compound as an intermediate compound in the preparation of peptide compounds. Thus, in both cases, compounds having an identical central cyclopropyl moiety with the same substituents are taught for the same utility. There is no attempt to restrict a compound used as an intermediate based on one utilized as a final product compound. Applicants allege that having substituents on different carbon atoms of the cyclopropyl moiety is a sufficient distinction. However, the difference in substituent positioning is merely one of positional isomers (see In re Norris, 179 F.2d 970, 84 USPQ 458 (CCPA 1970) and In re Jones, 162 F.2d 638, 74 USPQ 152 (CCPA 1947). The restriction of Group XI is maintained. Claims 73-80 are held withdrawn under 37 C.F.R. 1.142(b) by the examiner as directed to non-elected subject matter.

Next, applicants argue that they should be allowed to claim compounds by compound numbers with reference back to specific tables. Applicants state they are unaware of any prohibition against doing so. It is noted that rather than a prohibition, 37 C.F.R. 1.58 states that claims **may** contain tables if necessary to conform to 35 U.S.C. 112 or if desirable. In this application, the presence of a table is not needed to conform to 35 U.S.C. 112. Moreover, it is preferred, customary treatment that structures or nomenclature be used in claims, and not numbers that reference a table appearing in another claim or in the specification.

Finally, with respect to the proviso in claim 1, applicants have not indicated where in the specification support may be found for the amendment they propose. It is agreed that the proviso as originally written does not appear to make logical sense. However, substituent R₄ is defined in

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claim 1, lines 12-13, as an "...amido, or (lower alkyl)amide...". Hence, it is possible for R₄ to be an amide, even though a thioamide is not found within the definition. The specification at page 5, line 8 et seq., supports the proviso to claim 1 as originally presented. Without clear support to the contrary, applicants' proposed amendment must be considered new matter.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

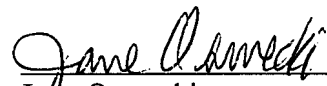
Telephone Inquiry Contacts

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jane Oswecki whose telephone number is (703)305-7152. The examiner can normally be reached Monday through Thursday from 7:30 AM to 5:30 PM EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane, can be reached at (703)308-4537. The telephone number for this Group is (703)308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703)308-1235.



Jane Oswecki
Primary Examiner
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12 April 2001